

THE UNITED STATES DISTRICT COURT FOR
SOUTHERN DISTRICT OF NEW YORK

06 CV 14447

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METROKANE INC.

Plaintiff,

v.

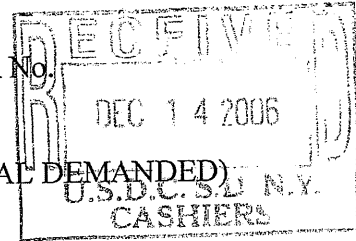
BUILT NY, INC.

Defendant.
-----X

JUDGE KAPLAN

Civil Action No.

(JURY TRIAL DEMANDED)



COMPLAINT FOR PATENT INFRINGEMENT

For their complaint herein, Plaintiff Metrokane Inc. ("Metrokane") alleges as follows:

PARTIES

1. Plaintiff Metrokane, is a corporation incorporated under the laws of New York with its principal place of business at 150 East 58th Street, 17th Floor, New York, New York 10155.

2. Upon information and belief, Defendant Built NY, Inc. ("Built NY") is a corporation incorporated under the laws of New York with its principle place of business at 520 Broadway, 2nd Floor, New York, NY 10012.

JURISDICTION AND VENUE

3. This is an action for: (1) declaratory judgment arising under the laws of the United States, 28 U.S.C. § 2201; and (2) for the tortious interference with business relations which is proper under 28 U.S.C. § 1367.

4. This Court has personal jurisdiction over Built NY, as it has undertaken significant commercial activity in New York, regularly transacts business in New York and maintains a place of business in New York.

5. Venue is proper in this Court under Title 28, United States Code §§ 1391 (c) and 1400 (b).

FACTS COMMON TO ALL CLAIMS

6. Metrokane designs and markets unique houseware products directed to, among other things, wine accessories. One of Metrokane's products, the "Houdini Wine to Go Insulated Carrier" ("the Houdini Wine Carrier") is used for the personal transporting of wine bottles.

7. Metrokane recently began marketing the Houdini Wine Carrier to Kohl's Department Store, Inc. ("Kohl's").

8. In a letter dated December 6, 2006, Built NY accused Metrokane of "intentionally infringing" its intellectual property rights. (Exhibit 1) Specifically, Built NY threatened Metrokane with infringement of U.S. Patent Number D520,229

and U.S. Trademarks Registration Numbers 3026873 and 3023095. (Collectively “Built NY’s intellectual property”) (Exhibit 2)

9. Contrary to Built NY’s claims, Metrokane had no knowledge of Built NY’s intellectual property and does not infringe the same.

10. In response to this letter, Metrokane’s counsel sent a letter to Built NY’s counsel stating that Metrokane was not infringing Built NY’s intellectual property and requesting that Built NY provide the basis for its infringement contentions. (Exhibit 3)

11. After Metrokane’s counsel sent his letter, Metrokane learned that Built NY had sent a separate letter dated December 6, 2006 to Metrokane’s customer Kohl’s apprising it of Metrokane’s allegedly infringing conduct. (Exhibit 4)

12. Metrokane’s marketing of its Houdini Wine Carrier has not infringed any of Built NY’s intellectual property and Metrokane’s continued marketing of the Houdini Wine Carrier will not infringe any of Built NY’s intellectual property in the future.

FIRST CLAIM

(Declaratory Judgment Of Non-Infringement)

13. Metrokane repeats and realleges each of the allegations contained in paragraphs 1 through 12 as if fully set forth herein.

14. In view of the threatening nature of the December 6, 2006 letter to Metrokane, an actual and justiciable controversy exists between Metrokane and Built NY.

15. Metrokane seeks a Declaratory Judgment of Non-Infringement of Built NY's intellectual property.

SECOND CLAIM

(Tortious Interference With Business Relations)

16. Metrokane realleges and incorporates by reference Paragraphs 1 through 15 as full set forth herein.

17. Through Kohl's purchases of the Houdini Wine Carrier, Kohl's has entered into business relations with Metrokane.

18. By advising Kohl's that Metrokane's Houdini Wine Carrier infringes Built NY's intellectual property, Built NY has made material misrepresentations to that customer and has detrimentally interfered with Metrokane's business relations.

19. The material misrepresentations made by Built NY to Kohl's were made with the primary purpose of harming Metrokane.

20. As a result of those misrepresentations, Metrokane's business relationship with Kohl's has been damaged in an amount to be determined at trial.

WHEREFORE, Metrokane prays for judgment as follows:

1. Metrokane has not infringed U.S. Patent Number D520,229 and U.S. Trademarks Registration Numbers 3026873 and 3023095;

2. Built NY has tortiously interfered with the business relationship of Metrokane;

3. Awarding actual damages to Metrokane in an amount to be determined;

4. Awarding Metrokane its costs and attorney's fees; and
5. Awarding such other relief as the Court deems just and proper.

Dated: December 13, 2006

Respectfully submitted,

PEARL COHEN ZEDEK LATZER, LLP

By: 

Lee A. Goldberg (LG-9423)

Nathan Buchek (NB-0246)

1500 Broadway, 12th Floor

New York, NY 10036

Tel: (646)878-0800

Fax: (646)878-0801

Attorneys for Plaintiff
Metrokane Inc.

12/11/2006 10:38 FAX 212 759 8630
Thacher Proffitt & 908.598.5710

METROKANE INC.
Page 2 of 4

1002
Fri Dec 08 2006 03:28:46 PM EST

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Summit, NJ 07901
908.598.5700

Fax: 908.598.5710
www.tpw.com

Direct Dial: 908.598.5878

MBisard@TPW.com

**Thacher
Proffitt**

December 6, 2006

**VIA FACSIMILE (212-759-8630)
& UNITED PARCEL SERVICE**

Ms. Riki Kane, *President*
MetroKane
150 E 58th St. 17th FL
New York, New York 10155

Attention: Legal Department

Re: Built NY Inc.'s Two Bottle Totes

Dear Ms. Kane:

This law firm represents Built NY Inc. ("Built NY"), the sole owner, creator and designer of an award-winning line of neoprene bottle totes, including the internationally popular Built NY® two-bottle tote.

Built NY's innovative product design has earned it ongoing and widespread positive media attention in the United States and abroad. In fact, the Built NY® two-bottle tote was named the Fortune 2003 Product of the Year and a Gold Medalist for the Business Week Annual Design Award 2004. Such creativity and innovation has likewise allowed Built NY to obtain significant intellectual property protection.

By way of example, not limitation, Built NY owns design (D520,229, EU 000210679) and pending utility patent protection on the Built NY® Two Bottle Tote. It also holds various trademark, trade dress and copyright rights on these product and its packaging including two registered U.S. trademarks (Reg. Nos. 3026873 and 3023095) on the Built NY® Two Bottle Tote.

It has come to our attention that MetroKane is intentionally infringing Built NY's intellectual property rights by importing, marketing and selling an exact replica of Built NY's at Kohl's department stores and upon Kohl's website. See Attachment I. Yet neither Kohl's or you have sought nor received from Built NY the authorization to commercially exploit or otherwise capitalize on Built NY's well-established and valuable intellectual property.

Built NY therefore demands you immediately;

New York, NY

Washington, DC

White Plains, NY

Summit, NJ

Mexico City, Mexico

12/11/2006 10:38 FAX 212 759 8630
Thacher Proffitt & Wood LLP 508.598.5710

METROKANE INC.
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003
Fri Dec 08 2006 03:29:45 PM EST

MetroKane
December 6, 2006

Page 2 of 5

- (1) disclose to us the source(s) of the infringing neoprene bottle totes (referred to as the "Houdini Wine to Go Insulated Carrier" on Kohls.com web site);
- (2) disclose to us the number of sales made and the number of infringing totes you have remaining in inventory and on order;
- (3) cease all unauthorized use, sale, marketing, distribution or manufacture of the infringing totes; and
- (4) destroy or, alternatively, deliver to us for destruction all unsold totes in your possession or under your care or control.

As our client considers this matter an urgent one, we require confirmation of your cooperation by the close of business **Wednesday, December 13, 2006**. Failure to comply with this request will force us to seek appropriate equitable and legal remedies. Built NY has authorized us to take all such actions.

Be advised, nothing in this communication constitutes a waiver of any of Built NY's rights, powers or remedies, and Built NY expressly reserves its right to pursue all remedies or claims against you which may exist in law or at equity.

Please have your legal representative contact me at the above number as soon as possible so we can work together to resolve this matter before further damage is done.

Sincerely,

THACHER PROFFITT & WOOD LLP


Mark Bisard

cc: Carter Weiss, CEO (Built NY)

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[illegible]



US00D520229S

(12) **United States Design Patent** (10) Patent No.: **US D520,229 S**
Lown et al. (45) Date of Patent: **** May 9, 2006**

(54) **BOTTLE TOTE WITH POCKET**

(75) Inventors: **Aaron Lown, Tuxedo, NY (US); John R. Swartz, Ridgewood, NJ (US)**

(73) Assignee: **Built NY, Inc., New York, NY (US)**

(**) Term: **14 Years**

(21) Appl. No.: **29/231,821**

(22) Filed: **Jun. 10, 2005**

(51) **LOC (8) Cl.** **09-01**

(52) **U.S. Cl.** **D3/202; D7/607; D7/624.2**

(58) **Field of Classification Search** **D3/202,**
D3/229, 230, 316; D9/444, 751; 62/457.1-457.8;
206/139, 428, 433; 220/509, 515, 737, 739,
220/903, DIG. 7; 383/10; D7/607, 608, 619.1,
D7/622, 624.2, 624.3, 709

See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

D117,147 S * 10/1939 Karoff D7/719
D142,442 S * 9/1945 Rath D3/246
D167,207 S * 7/1952 Haars D7/624.3
4,560,068 A * 12/1985 Membrino 206/554
D376,956 S * 12/1996 Sharp D7/607
5,624,048 A * 4/1997 Sander et al. 215/395

D399,707 S * 10/1998 Villarreal et al. D7/607
D404,620 S * 1/1999 Rausch D7/709
D435,964 S * 1/2001 Lentz D3/239
D466,002 S * 11/2002 Jones D9/710
D469,956 S * 2/2003 Cone et al. D3/303
D489,526 S * 5/2004 Held D3/203.1

* cited by examiner

Primary Examiner—Louis S. Zarfes

Assistant Examiner—John Windmuller

(74) *Attorney, Agent, or Firm*—Lackebach Siegel, LLP

(57) **CLAIM**

The ornamental design for a bottle tote with pocket, as shown and described.

DESCRIPTION

FIG. 1 is a front elevational view of a bottle tote with pocket showing our new design;

FIG. 2 is a rear elevational view thereof;

FIG. 3 is a top plan view thereof;

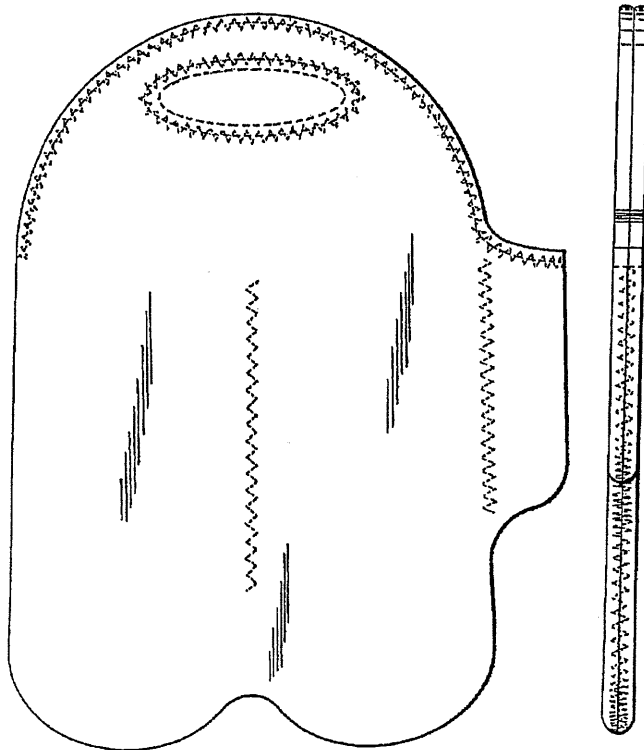
FIG. 4 is a bottom plan view thereof;

FIG. 5 is a left side elevational view thereof; and,

FIG. 6 is a right side elevational view thereof.

The broken line showing of stitching and a handle opening is for illustrative purposes only and forms no part of the claimed design.

1 Claim, 4 Drawing Sheets



U.S. Patent

May 9, 2006

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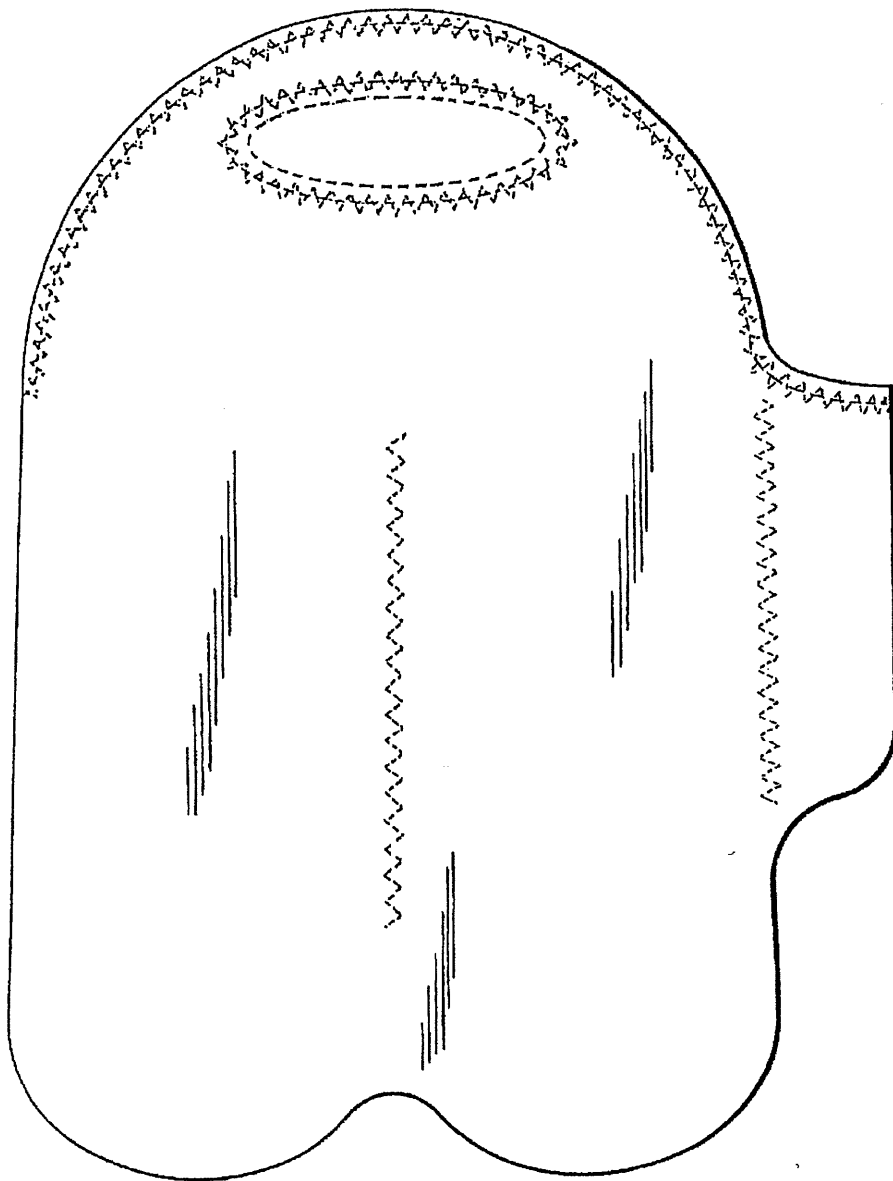


FIG. 1

U.S. Patent

May 9, 2006

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US D520,229 S

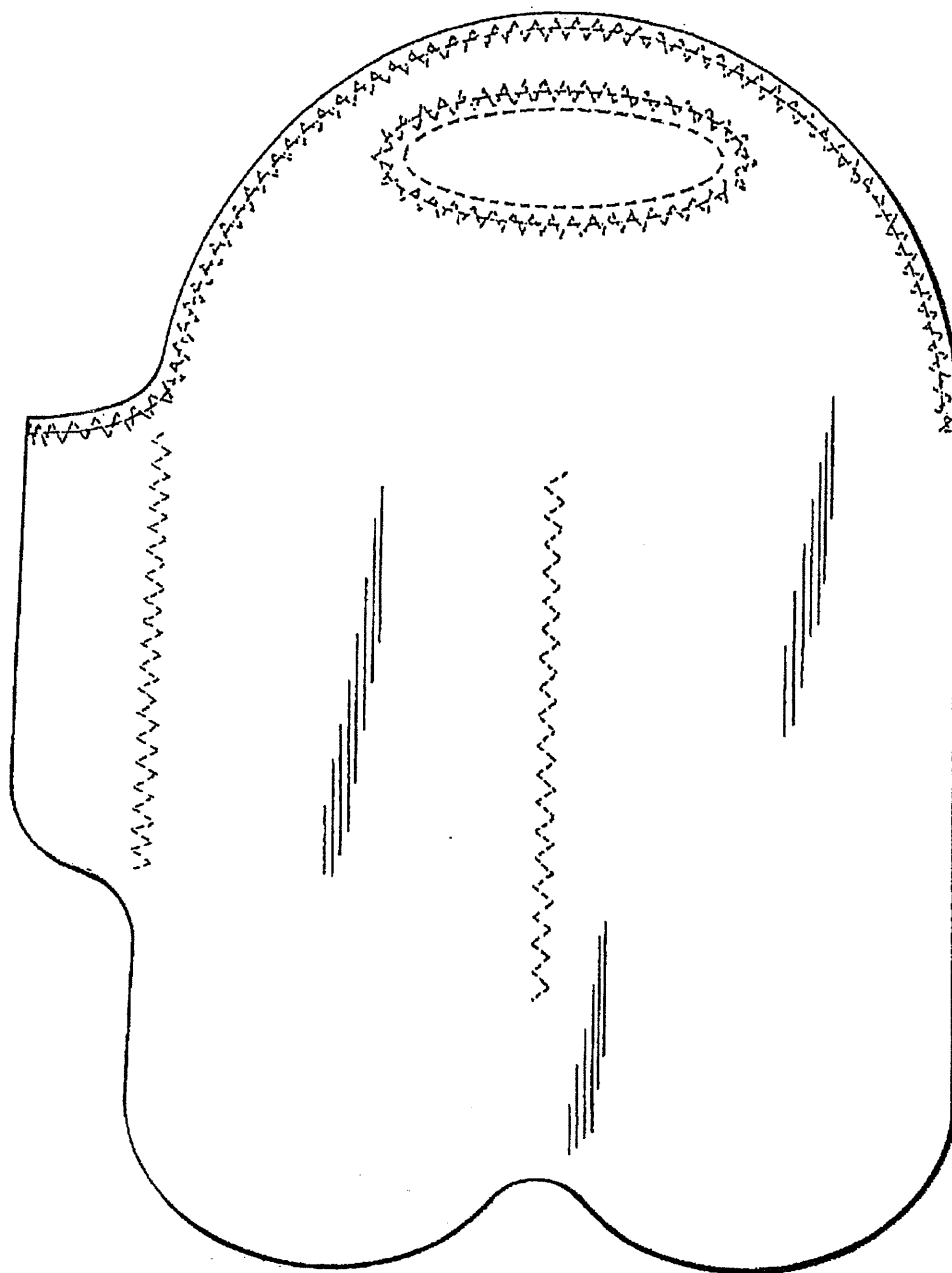


FIG.2

U.S. Patent

May 9, 2006

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US D520,229 S

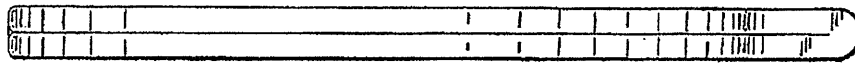


FIG. 3



FIG. 4

U.S. Patent

May 9, 2006

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US D520,229 S

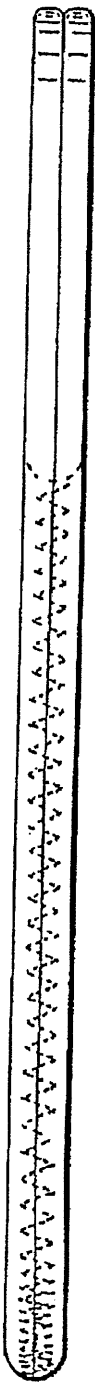


FIG. 5

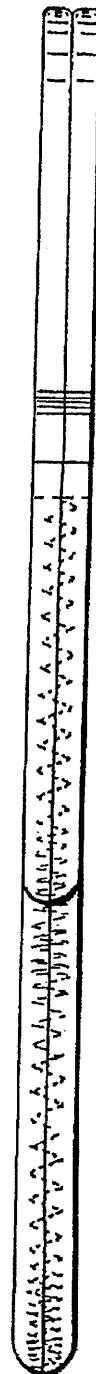


FIG. 6

Int. Cl.: 21

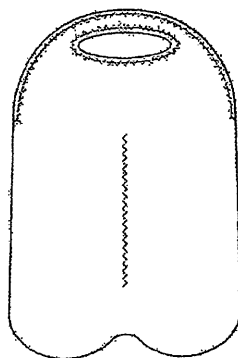
Prior U.S. Cls.: 2, 13, 23, 29, 30, 33, 40 and 50

Reg. No. 3,023,095

United States Patent and Trademark Office

Registered Dec. 6, 2005

**TRADEMARK
PRINCIPAL REGISTER**



BUILT NY, INC. (NEW YORK CORPORATION)
94 CLINTON ROAD
TUXEDO, NY 10987

FOR: THERMAL INSULATED BOTTLE TOTES
FOR BEVERAGES, IN CLASS 21 (U.S. CLS. 2, 13, 23,
29, 30, 33, 40 AND 50).

FIRST USE 4-28-2003; IN COMMERCE 4-28-2003.

THE MARK CONSISTS OF THE CONFIGURA-
TION OF A BEVERAGE TOTE HAVING TWO DIS-

TINCT CHAMBERS. THE PORTION OF THE MARK
SHOWN IN DOTTED LINE REPRESENTS STITCH-
ING ON THE TOTE AND IS CLAIMED AS A
FEATURE OF THE MARK .

SEC. 2(F).

SER. NO. 78-395,303, FILED 4-2-2004.

JANICE L. MCMORROW, EXAMINING ATTOR-
NEY

Int. Cl.: 21

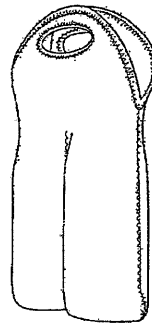
Prior U.S. Cls.: 2, 13, 23, 29, 30, 33, 40 and 50

Reg. No. 3,026,873

United States Patent and Trademark Office

Registered Dec. 13, 2005

TRADEMARK
PRINCIPAL REGISTER



BUILT NY, INC. (NEW YORK CORPORATION)
94 CLINTON ROAD
TUXEDO, NY 10987

FOR: THERMAL INSULATED BOTTLE TOTES
FOR BEVERAGES, IN CLASS 21 (U.S. CLS. 2, 13, 23,
29, 30, 33, 40 AND 50).

FIRST USE 4-28-2003; IN COMMERCE 4-28-2003.

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TION OF A BEVERAGE TOTE HAVING TWO DIS-

TINCT CHAMBERS WHEN FILLED. THE PORTION
OF THE MARK SHOWN IN DOTTED LINES RE-
PRESENTS STITCHING ON THE TOTE AND IS
CLAIMED AS A FEATURE OF THE MARK.

SEC. 2(F).

SER. NO. 78-395,271, FILED 4-2-2004.

JULIE WATSON, EXAMINING ATTORNEY



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December 12, 2006

Direct Dial: 646-878-0814
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Via Facsimile
Mark Bisard
Thacher Proffitt & Wood LLP
25 DeForest Avenue
Summit, NJ 07901

RE: Built NY Inc.'s Two Bottle Totes

Dear Mr. Bisard:

We are counsel to Metrokane on intellectual property matters. As such, we are in receipt of your letter of December 6, 2006.

We have just ordered the file history of U.S. Patent No. D520,229, and therefore, need a reasonable amount of time to more fully respond to your letter.

In the meantime, we would appreciate you more fully explaining the basis for your belief that Metrokane is "intentionally infringing Built NY's intellectual property rights." As you are aware, the mere issuance of a patent does confer notice on the market. Moreover, I am not aware of any patent number marked on the Built NY product; nor am I aware that Metrokane was given any notice of the patent at issue, but for your December 6th letter.

Further, on its face it appears that Metrokane's "Houdini Wine to Go Insulated Carrier" does not infringe the intellectual property at issue. However, in view of Built NY's required due diligence under Rule 11 of the Federal Rules of Civil Procedure, we request that you supply us with your views as to how Built NY: 1. interprets its patent claim at issue, and, 2. how this interpreted claim encompasses the accused product.



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Once we receive your response along with the patent file history, we will endeavor to respond promptly to your assertions in an effort to find an amicable solution.

Very truly yours,

Lee A. Goldberg
Pearl Cohen Zedek Latzer, LLP

cc: Riki Kane

12/12/2006 17:44 FAX 212 759 8630
DEC-12-2006 15:16 From: KEN GRAVE, INC
12627037274 KOHL'S LEGAL

METROKANE INC.
630 323 4174

002
To: 212 759 8630 P. 3/4
06 26 45 p.m 12-12-2006 3/4

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Proffitt**



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December 6, 2006

VIA UPS

Kohl's Department Stores, Inc.
N56 W17000 Ridgewood Drive
Menomonee Falls, Wisconsin, 53051

ATTENTION: LEGAL DEPARTMENT

Re: Built NY Inc.'s Bottle Totes

Dear Legal Department:

This law firm represents Built NY Inc. ("Built NY"), the sole owner, creator and designer of an award-winning line of neoprene bottle totes, including the internationally popular Built NY[®] two-bottle totes (the "Built NY Totes").

It has come to our attention that Kohl's, has been marketing and selling an item infringing Built NY's two-bottle tote. For your reference, the infringing articles identified on your web site are listed as Model numbers 2563 (Black) and 2565 (Red). They are named the "Houdini Wine to Go Insulated Carrier" (the "Houdini Bags"). The sale of the infringing bag was surprising to Built NY given Kohl's purchasing representatives have been engaged with Built NY representatives for some time now and are in receipt of materials clearly highlighting the Built NY two bottle tote and the intellectual property resident therein. To our knowledge, neither Kohl's nor the maker of "Houdini Bags" have sought, or received, Built NY's authorization to use or to market any of Built NY's intellectual property.

We are certain that a company with Kohl's stature appreciates the importance of intellectual property having so much of its own. Kohl's must therefore be aware of Built NY's obligation to protect its own substantial intellectual property portfolio including U.S. and foreign patent, trademark, copyright and trade dress protection in its various Built NY Totes.